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| In re Application | : |
| Lu, et al. | : |
| Application No. 09/688,017 | : DECISION ON APPLICATION |
| Filed: October 13, 2000 | : FOR PATENT TERM ADJUSTMENT |
| Atty Docket No. 20054-001110US | : |

This is a decision on the "RESUBMISSION OF APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705", filed April 29, 2005. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to forty-two (42) days.

For the reasons set forth below, a decision on the request for reconsideration of the patent term adjustment indicated on the patent application is being **HELD IN ABEYANCE** until issuance of the patent. However, a review of the application reveals that applicants should have been assessed additional delay of ninety four (94) days. The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is zero (0) days, including three hundred fifty-eight (358) days of applicant delay. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

Applicants are given two months from the issue date of the patent to request reconsideration of the patent term adjustment indicated on the patent. Because Applicants did not pay the \$200 fee set forth in 37 C.F.R. § 1.18(e) with the instant petition, applicants should pay this fee on request for reconsideration. A copy of this decision should accompany applicants' written request.

On December 16, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days. On February 23, 2005, applicants submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is forty-two (42) days. However, because applicants did not include the required fee, the application was dismissed in a decision mailed on April 26, 2005. Applicants were given thirty (30) days to respond.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of two hundred (200) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), reduced by applicants' delays of eighty-three (83), eighty-nine (89), and ninety-two (92) days, pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b).

However, applicants assert additional PTO delay of one hundred six (106) days for the failure on the part of the Office to issue the patent within three years of its filing. **The Office does not assess whether or not any additional PTA is accorded in this instance until the issue date is established, even where applicants filed an RCE.¹**

Furthermore, applicants should have been assessed additional delay for their late filing of the RCE. A final Office action was mailed on July 28, 2003. Applicants did not file a proper response until they filed an RCE on January 28, 2004 (made timely

¹ Applicants should note that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period of pendency before the Office except for periods excluded under 35 U.S.C. (b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A).

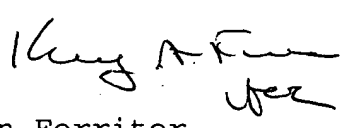
for purposes of avoiding abandonment by obtaining a three month extension of time). Accordingly, pursuant to 37 C.F.R. § 1.704(b), ninety-two (92) days of applicant delay should have been assessed. In addition, applicants filed an IDS two days later on January 30, 2004. Pursuant to 37 C.F.R. § 1.704(c)(8), two (2) days of applicant delay should have been assessed for the filing of this supplemental reply.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **zero (0) days** (200 days of PTO delay and 358 (83+89+92+92+2) days of applicant delay).

The \$200 fee set forth in 37 C.F.R. § 1.18(e) has been charged to Deposit Account No. 20-1430, as authorized.

The application file is being forwarded to the Office of Patent Publication for timely issuance of the patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.


Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen